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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,576	08/27/2002	Lewis Dewi	NIDN-73247	3162

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AMERSHAM HEALTH
IP DEPARTMENT
101 CARNEGIE CENTER
PRINCETON, NJ 08540-6231

EXAMINER	
JONES, DAMERON LEVEST	
ART UNIT	**PAPER NUMBER**
1618	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/009,576	DEWI ET AL.	
	Examiner	Art Unit	
	D. L. Jones	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-10,13 and 14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-10, 13, and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 6/2/05 wherein claim 1 is amended and claims 2, 3, 11, 12, and 15 are canceled.

Note: Claims 1, 4-10, 13, and 14 are pending.

RESPONSE TO APPLICANT'S AMENDMENTS/ARGUMENTS

2. The Applicant's arguments filed 6/2/05 to the rejection of claims 1, 4-10, 13, and 14 made by the Examiner under 35 USC 103 and/or 112 have been fully considered and deemed non-persuasive for the reasons set forth below.

112 First Paragraph Rejection

The rejection of claims 1, 4-10, 13, and 14 under 35 USC 112, first paragraph, rejection as being enabling for specific species is MAINTAINED for reasons of record in the office action mailed 11/30/04.

Applicant asserts that the incorporation of the phrase 'containing covalently bonded iodine wherein the iodine is bonded to at least one other atom which is not a halogen wherein said iodine containing compound is' restricts the compound to specific species.

The incorporation of the phrase as set forth in the amended claims does not overcome the rejection because the claim reads on all iodine containing compounds attached to any atom other than a halogen which Applicant is still not entitled to based on the scope of enablement rejection of record. Applicant is not enabled for all iodine substrates as set forth in the claim.

112 Second Paragraph Rejection

The rejection of claims 1, 4-10, 13, and 14 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is MAINTAINED for reasons of record in the office action mailed 11/30/04 and those set forth below.

Applicant is once again asserting that that the intended use of the product, 'for use in brachytherapy' should be given patentable weight.

Applicant is once again reminded that a recitation of intended utility in the preamble does not impart patentability to a known composition (In re Spada, 911, F.2d 705, 15 U.S.P.Q. 2d 1655 (Fed. Cir. 1990)). Thus, an intended use clause found in the preamble of a product claim is not afforded the effect of a distinguishing limitation wherein the product is a self-contained descript of the structure (i.e., product) not depending on the preamble for completeness. Hence, the product comprises a biocompatible echogenic container and a radioactive isotope of iodide ion or an iodine containing compound as set forth in claim 1..

103 Rejection

The rejection of claims 1, 4-10, 13, and 14 under 35 USC 103(a) as being unpatentable over Suthanthiran et al (US Patent No. 4,994,013) is MAINTAINED for reasons of record in the office action mailed 11/30/04 and those set forth below.

Applicant's arguments may be summarized as the intended use of the radioactive source was not given patentable weight and thus, patentability should be not be based solely on the product components.

According to MPEP 2111.02, a preamble is non-limiting unless it breathes life and meaning into the claim. In particular, the preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be 'essential to point out the invention defined by the claim'. Generally, a preamble is not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness, but instead, the process steps or structural limitation are able to stand alone. In a composition claim, the preamble is generally non-limiting if the preamble merely recites an inherent property. This is not the case in Applicant's invention. Also, the intended use may further limit the claim if it does more than merely state purpose or intended use. This is also not the case for the instant invention. Hence, the patentability of the instant invention is based on the components present in the product.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. L. Jones
Primary Examiner
Art Unit 1618

August 22, 2005